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Notice of Allowability

Application No.

10/040,863

Examiner

Manjunath N. Rao, Ph.D.

Applicant(s)

HOLMES ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the paper filed on 12-28-04.
2. ☒ The allowed claim(s) is/are 48-54 and 63-75.
3. ☒ The drawings filed on 01 November 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Manjunath N. Rao, Ph.D.
Primary Examiner
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DETAILED ACTION**CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-28-04 has been entered.

Claims 48-54, 63-75 are currently pending in this application.

Applicants' amendments and arguments filed on 12-28-04, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically, Examiner has withdrawn the previous rejections held under 35 U.S.C. 102(b) and 103(a) in view of the arguments provided by the applicant, that the reference does not disclose a polypeptide that inherently has the same characteristics of the polypeptides used in the claimed method.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by

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37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Brian W. Poor on 3-4-05.

The application has been amended as follows:

In the specification:

A) Insert the following on the first page of the specification beginning as line 1,

--The present application is a divisional application of United States Serial

Number 09/298,866, filed April 23, 1999, now US 6,329,170, the entire disclosure of which is hereby incorporated by reference.—

B) Please delete the following “(www.ncbi.nlm.nih.gov)” on page 34, line 2.

In the claims:

A) Please delete the phrase “in the substantial absence of other rat proteins” in claim 48.

B) Please delete the phrase “in the substantial absence of other rat proteins” in claim 49.

C) Please delete the phrase “in the substantial absence of other rat proteins” in claim 51.

D) Please delete the phrase “in the substantial absence of other rat proteins” in claim 52.

E) Please delete the phrase “in the substantial absence of other rat proteins” in claim 53.

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F) Please delete the phrase “in the substantial absence of other rat proteins” in claim 63.

G) Please delete the phrase “in the substantial absence of other rat proteins” in claim 64.

F) Please delete the phrase “in the substantial absence of other rat proteins” in claim 65.

G) Please delete the phrase “in the substantial absence of other rat proteins” in claim 66.

H) Please delete the phrase “in the substantial absence of other rat proteins” in claim 71.

I) Please delete the phrase “in the substantial absence of other rat proteins” in claim 72.

Allowable Subject Matter

Claims 48-54, 63-75 are allowed.

The following is an examiner’s statement of reasons for allowance: Following a diligent search it was determined that the prior art neither teaches nor suggests a method for preparative synthesis of a molecule comprising fucose using a recombinant fucosyltransferase comprising the amino acid sequence SEQ ID NO:8 encoded by SEQ ID NO:7 or the recombinantly fucosyltransferase comprising the amino acid sequence SEQ ID NO:10 encoded by SEQ ID NO:9 as claimed in claims 48-54, 63-75.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.
Primary Examiner
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March 7, 2005